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Paper No. 22

## UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte RANDAL LEE BERTMAN,  
DAVID FREDERICK CHAMPION,  
and PETER JAMES BRITTENHAM

Appeal No. 2002-0307  
Application 09/143,967

MAILED

MAY 9 - 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

## ON BRIEF

Before JERRY SMITH, DIXON, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 37-45, 47-57, 59-69, 71 and 72. Claims 1-36 have been cancelled. Claims 46, 58 and 70 have been indicated to contain allowable subject matter. An amendment after final rejection was filed on July 6, 2001 but was denied entry by the examiner.

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The disclosed invention pertains to a mobile client computer. A particular feature of the invention is that it uses a predictive widget to supply a predictive data default or a predictive data fill for data to be entered by the user in defined data fields.

Representative claim 37 is reproduced as follows:

37. A mobile client computer comprising:

a housing sized to be held and manipulated by the hand of a user;

a processor mounted within the housing for processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

a display mounted in the housing and coupled to the processor and the memory for displaying information derived from digital data processed by the processor;

an input digitizer mounted in the housing and overlaying the display, the digitizer being coupled to the processor for input of digital data by a user; and

a control program stored in the memory and accessible by the processor for directing the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a) displaying a form defining data fields; and

b) exercising a predictive widget to supply a data entry for a defined data field.

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The examiner relies on the following references:

Dipaolo et al. (Dipaolo)	5,367,619	Nov. 22, 1994
Capps	5,666,502	Sep. 09, 1997

Claims 37-45, 47-57, 59-69, 71 and 72 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Capps in view of Dipaolo.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts

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to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

The examiner cites Capps as teaching a mobile client computer which uses a predictive widget to suggest probable inputs intended by the user. The examiner essentially finds that Capps teaches the claimed invention except for the automatic entry of data to a selected data field without being selected by the user. The examiner cites Dipaolo as teaching that a data field can be automatically filled in. The examiner finds that it would have been obvious to the artisan to automatically fill in data in the Capps device as taught by Dipaolo. The examiner also finds that each of the other claimed features are disclosed by

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either Capps or Dipaolo [rejection, pages 3-6 from Paper No. 3]<sup>1</sup>.

Appellants argue that there is no motivation to combine the teachings of Capps with Dipaolo because Dipaolo teaches automatically filling in a data entry when there is only one valid data entry whereas Capps relates to the situation where the user has a choice of data entries. Thus, appellants argue that the automatic filling in a data entry as taught by DiPaolo would never apply in Capps. Appellants also argue that the proposed modification of Capps with Dipaolo would change the principle of operation in Capps [brief, pages 6-9]. With respect to the independent claims, appellants also argue that there is nothing predictive when there can be only one valid data entry as taught by Dipaolo nor can there be both a predictive default and a predictive fill.

The examiner responds that the only item of Dipaolo, which is automatically filled in, is considered the most probable item and that it would have been obvious to automatically enter this item in the device of Capps. Thus, the examiner responds

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<sup>1</sup> Although the examiner's answer incorporates the final rejection (Paper No. 5), the final rejection does not explain the rationale behind the rejection, but instead, refers to the rejection of Paper No. 3. This type of indirect incorporation of rejections should be avoided by the examiner. Note MPEP § 1208(A).

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that Capps teaches providing a list of most probable items to the user and Dipaolo teaches automatically entering the most probable item. Finally, the examiner observes that claims are given their broadest reasonable interpretation during prosecution and that the last step of claim 37 could be construed as requiring only the supplying of a list of data entries using a predictive widget [answer, pages 3-8].

Appellants respond that filling in a data field that can have only one data entry is not associated with any probability. Appellants also repeat their main position that Dipaolo only applies when there is only one valid data entry so that there is no motivation to combine it with the teachings of Capps [reply brief].

We cannot sustain the rejection of the claims as formulated by the examiner. We agree with appellants that there is no logical basis for modifying the Capps device with the teachings of Dipaolo. Capps has no intention to prejudge the entry actually intended by the user. All Capps wants to do is provide a list of possible entries to the user which probably contains the entry intended by the user. The user must select the actual entry intended and the list serves only to aid the user in finding the intended entry. Dipaolo teaches that a data

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field should be automatically filled in when there is only one valid data entry. Thus, we agree with appellants that this teaching of Dipaolo would never apply to Capps because Capps relates to a plurality of possible entries and a predictive widget for compiling this list. Thus, not only does the automatic entry of data in Dipaolo only apply to situations where there is only one valid data entry, but the automatic entry of data completely defeats the purpose of Capps which is to allow the user to determine the correct data entry from the list. Therefore, the examiner's rejection fails because there is simply no rational basis for combining the teachings of Dipaolo with the teachings of Capps.

The examiner does make one very good point, however, although the examiner never explores the point raised. Specifically, the examiner properly notes that claims are given their broadest reasonable interpretation during prosecution. The examiner raises this point by questioning if the last step of claim 37 can be construed to mean exercising a predictive widget to supply a list of data entries which contains the data entry for a defined data field, i.e., the predictive widget predicts a list of data entries rather than an entry from the list [answer, page 7]. This is a very good question although the examiner does

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not further explore just what this question implies.

Although there is clearly no basis for combining the teachings of Dipaolo with the teachings of Capps as proposed by the examiner, it may be argued that Dipaolo is unnecessary to support the rejection of claim 37 when it is given its broadest reasonable interpretation. Specifically, it could be argued that the user in Capps who selects an entry from the list of entries supplied by the predictive widget in Capps has performed the step of exercising a predictive widget to supply a data entry for a defined data field. The selection by the user which supplies a data entry for the data field has clearly been based on a predictive widget which has been exercised by the computer in Capps. In other words, it is not clear whether the last step of claim 37 requires that a data field be filled in automatically as assumed by the examiner. Whether this interpretation of the last step of claim 37 is appropriate is a question of fact which has not been argued on this record. We will not attempt to answer this question on this record although the examiner may determine that the question should be explored in response to this decision.

Since the examiner's rejection of all claims is based upon the improper combination of Capps with Dipaolo, we will not

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sustain the examiner's rejection of any of the claims on appeal. Since the examiner may wish to explore whether Capps teaches the last step of the independent claims as noted above, and in order for the record in this application to be complete, we also consider the other issues raised by appellants in their briefs. With respect to the claims reciting a predictive default and a predictive fill, Capps does not teach use of a predictive default, but Capps does teach use of a predictive fill. Capps teaches that the predictive fill can be based on a recency of use of listed data entries, a frequency of use of the listed data entries, or a weighted average of these two determinations. Although the specific sequencing of the data entries recited in claim 46 is not specifically described in Capps, the limitation in claim 46 could be considered obvious based on the fact that Capps teaches use of a weighted average as discussed above.

In summary, we have not sustained the examiner's rejection of the claims on appeal because there is no logical basis to combine the automatic filling step of Dipaolo with the device of Capps. Therefore, the decision of the examiner rejecting claims 37-45, 47-57, 59-69, 71 and 72 is reversed. We have also raised the question of whether the claimed invention requires that data be automatically filled in as interpreted by

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the examiner. We have left it up to the examiner to determine if the broadest reasonable interpretation of the claims even requires that Dipaolo be used. It should not be assumed that this decision has prejudged the scope of claim question either way.

REVERSED

*Jerry Smith*

JERRY SMITH )  
Administrative Patent Judge )

*Joseph L. Dixon*

JOSEPH L. DIXON )  
Administrative Patent Judge )  
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